

REMARKS

The provisional obviousness-type double patenting rejecting is maintained, despite the claim amendments. The following remarks were included on page 2, paragraph 2 of the office action:

The amendments to the claims limiting the filler to zirconia does not overcome the rejection since the claims of 10/337,575 reasonably include the filler as disclosed as suitable in the specification wherein zirconia is disclosed.

To the contrary, the claims of 10/337,575 do not expressly cover zirconia. The test, where the two applications are filed on the same day, is whether "the invention defined in the claim of the application would have been an obvious variation of the invention defined in a claim in the patent." See M.P.E.P. § 804(a) at page 800-22 (Emphasis added). Since the claims in the other application do not specifically claim zirconia, and zirconia is not an obvious variant of what is claimed, then the present claims are not obvious over the prior claims. Resort to the specification and what is disclosed is inappropriate in a double patenting analysis.

Therefore, reconsideration is requested in view of the fact that the specification cannot be used in a double patenting rejection and the provision of zirconia, instead of other materials, is not obvious for the reasons further discussed below.

Further, in paragraph 3, the following arguments were made:

1. The Declaration Lacks Details of Comparisons
Performed, E.G., Particle Sizes and Concentration

The suggestion that some detail might be needed is noted, but it is not seen why any details are needed. The point of the declaration is not that any specific details render the claimed invention obvious or not, but, instead, that the use of zirconia, in and of itself, renders the claim non-obvious over prior art which teaches silica. Thus, there is no reason to give additional details because the point is that generically silica cannot render obvious the claimed invention to zirconia in these circumstances.

2. There is No Basis in the Specification
for Thixotropy Being Important or Critical

There is no requirement that anything be placed in the specification to support unobviousness. M.P.E.P. § 716.02(f). Therefore, it does not matter whether the specification indicates that thixotropy is important or critical.

3. The Specification Discloses Zirconia and Silica as Being Equivalent

Again, M.P.E.P. § 716.02(f) expressly indicates that there is no requirement that any of the arguments of non-obviousness be placed in the specification. Therefore, since the best mode is disclosed, the fact that advantages to one or the other species is not discussed, is of no importance.

4. The Declaration is Not Commensurate
With the Narrower Scope of the Claims

The test is whether the affidavit indicates effectiveness over the entire claimed range. See M.P.E.P. § 716.02(d). Here, the showing in the declaration is broader than the claims and shows that, over the entire range and a broader range, zirconia would unexpectedly be more effective than silica. Thus, there is no requirement that a showing that for these purposes zirconia is generically unexpectedly better needs to be supplemented by showing that, in each individual case claimed, that zirconia is better. It is better in general and, therefore, it is better in specific.

Therefore, in view of these remarks, reconsideration is requested.

Respectfully submitted,



Date: January 17, 2006

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